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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/738,468	12/17/2003	William R. Nolan III	037607-0236	8205
34099	7590	08/21/2008		
FANN-MKE C/O FOLEY & LARDNER LLP 777 EAST WISCONSIN AVENUE MILWAUKEE, WI 53202-5306			EXAMINER	
			OYEBISI, OJO O	
			ART UNIT	PAPER NUMBER
			3696	
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			08/21/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/738,468

**Applicant(s)**

NOLAN, WILLIAM R.

**Examiner**

OJO O. OYEBISI

**Art Unit**

3696

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 33-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-859)
- Paper No(s)/Mail Date 05/04/05, 12/21/07, 02/27/08
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

In response to the restriction requirement mailed on 04/14/08, the following have occurred: the applicant has elected the invention of group III (claims 33-44) for prosecution on the merits, claims 1-32 from non-elected groups I and II have been cancelled.

#### ***Claim Rejections - 35 USC §101***

1. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 34-37 and claims 40-42 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.
3. Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (the Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).
4. If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. §101.

5. In this particular case, regarding the first test, in performing the steps of the claimed subject matter, there is no requirement that a machine be used, thus the claims are not considered sufficiently tied to another statutory class. Regarding the second test, since the claimed subject matter may be performed using only human intelligence, the steps do not sufficiently transform the underlying subject matter to be statutory. Thus, to qualify as a 101 statutory method, the claim should positively recite the other statutory class (the thing or product) to which it is tied. In the present case, claims 34-37 and claims 40-42 are merely describing loan data, and thus not sufficiently tied to another statutory class (i.e., product or thing).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 33-44 are rejected under 35 U.S.C. 102 (e) as being anticipated by Heffner et al (Heffner hereinafter, US Pub. No.: 2003/0018558).

**Re claim 33.** Heffner discloses a method of displaying information in a data processing system for processing loan information, comprising: providing a web-based interface accessible to a seller of mortgage loans (see the abstract), the web- based interface including an interface configured to permit the seller to associate a unique seller marketing name with each of a plurality of different types of loan products the seller is eligible to sell to a purchaser (i.e., loans in the pool, see paras 0270 - 0271, Heffner further describes different types of loan in the seller published loan pool i.e., sub-prime, jumbo, conforming, home-equity products), the different types of loan products including home mortgage loan products with different sets of attributes (see paras 0271); providing a computer database coupled to the web-based interface and configured to store data for the different types of loan products the seller is eligible to sell to the purchaser, wherein the data for each loan product includes a purchaser-assigned name; displaying a loan product list to the seller via the web-based interface (see paras 0123); receiving a customization request from the seller via the web-based loan interface (i.e., characteristic/profile of a pool of loan, see paras 0164-0168) including receiving a selection of a product type and receiving a request to associate a seller marketing name with the product type (i.e., pool and product, see fig.24, also see paras 0164-0168. Note that the published loan profile inherently contains seller marketing loan for the loan product i.e., FHLMC Gold and GNMA 1 PRODUCT etc); receiving a seller-assigned name from the seller for the product type (see paras 0164-0168); storing the association of the seller marketing name with the product type (Heffner discloses the storage of loan information in database – see paras 0043, which inherently includes the seller

marketing name with the product type); displaying the seller marketing name in place of or in addition to the product type following the association (see fig.24); permitting the seller to enter into a commitment to sell a loan identified by the seller marketing name (see fig.15 A, also see paras 0165); wherein the method is performed by a computer system associated with a participant in the secondary mortgage market (see fig.2a and fig.2B)

**Re claim 34.** Heffner further discloses a method according to claim 33, wherein the loan data for each loan further includes a set of attributes for each loan (see paras 0271).

**Re claim 35.** Heffner further discloses a method according to claim 34, wherein the set of attributes for each loan includes a loan term, a loan type, and an interest rate (see paras 0086, also see fig.21A element 2104).

**Re claim 36.** Heffner further discloses a method according to claim 35, wherein the customization request is based upon the set of attributes for each loan (see paras 0271)

**Re claim 37.** Heffner further discloses a method according to claim 33, wherein displaying the seller- assigned name for each loan include in the seller loan list includes graphically displaying each seller-assigned name proximate the purchaser-assigned name associated with each seller- assigned name (i.e., pool and product, see fig.24, also see paras 0164-0168. Note that the published loan profile inherently contains seller marketing loan for the loan product i.e., FHLMC Gold and GNMA 1 PRODUCT etc)

**Re claim 38.** Heffner further discloses a method according to claim 33, further comprising: receiving a modification request from the seller via the web-based interface, wherein the modification request is associated with the seller-assigned names for at

least one loan; and editing the selection list based upon the modification request (see paras 0311).

**Re claim 39.** Heffner further discloses a method of displaying information in a data processing system for processing loan information, comprising: receiving a seller identifier via a computer interface from the seller (see paras 0044-0045); retrieving data for each of a plurality of different types of loan products the seller is eligible to sell to the purchaser from the computer database including the seller identifier (see fig.18; see fig.21A, also see fig.22), displaying a seller loan product list to the seller via the computer interface, the seller loan product list including the purchaser-assigned name associated with the loan products the seller is eligible to sell to the purchaser including the seller identifier (i.e., pool and product, see fig.24, also see paras 0164-0168. Note that the published loan profile inherently contains seller marketing loan for the loan product i.e., FHLMC Gold and GNMA 1 PRODUCT etc); receiving a customization request from the seller via the computer interface (i.e., characteristic/profile of a pool of loan, see paras 0164-0168), including receiving a selection input of a product type and receiving a request to associate a unique seller marketing name with the product type (i.e., pool and product, see fig.24, also see paras 0164-0168. Note that the published loan profile inherently contains seller marketing loan for the loan product i.e., FHLMC Gold and GNMA 1 PRODUCT etc), the product type being a type of home mortgage loan including a set of attributes (see paras 0271); generating a selection list based on the selection input, wherein the selection list includes at least one selected purchaser-assigned name for the product type identified by the selection input (see fig.18, 23 and

24); displaying the selection list to the seller via the computer interface (see fig.18); receiving a seller-assigned name from the seller for the product type identified by the selection input-via the computer interface (see paras 0164-0168); storing the seller-assigned name and the association of the seller marketing name with the product type in the computer database (Heffner discloses the storage of loan information in database – see paras 0043, which inherently includes the seller marketing name with the product type); configuring the computer interface so that upon receiving one of the seller-assigned name and a purchaser-assigned name associated with the seller-assigned name via the computer interface, the loan data associated with the seller-assigned name is retrieved from the computer database and displayed to the seller via the computer interface (see fig.18, 21A and 22); and displaying the selection list including the seller-assigned name to the seller via the computer interface (see fig.24)

**Re claim 40.** Claim 40 recites similar limitations to claim 34 and thus rejected using the same art and rationale as in claim 34.

**Re claim 41.** Claim 41 recites similar limitations to claim 35 and thus rejected using the same art and rationale as in claim 35.

**Re claim 42.** Claim 42 recites similar limitations to claim 36 and thus rejected using the same art and rationale as in claim 36.

**Re claim 43.** Claim 43 recites similar limitations to claim 37 and thus rejected using the same art and rationale as in claim 37.

**Re claim 44.** Claim 44 recites similar limitations to claim 38 and thus rejected using the same art and rationale as in claim 38.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571)272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OJO O OYEBISI/  
Primary Examiner, Art Unit 3696